



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/397,455

09/16/1999

NED M SMITH

116536-153402

8766

31817

7590

02/22/2008

SCHWABE, WILLIAMSON & WYATT, P.C.  
PACWEST CENTER, SUITE 1900  
1211 S.W. FIFTH AVE.  
PORTLAND, OR 97204

EXAMINER

FIELDS, COURTNEY D

ART UNIT

PAPER NUMBER

2137

MAIL DATE

DELIVERY MODE

02/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/397,455	<b>Applicant(s)</b> SMITH, NED M	
	<b>Examiner</b> COURTNEY D. FIELDS	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 3, 12, and 22 have been cancelled.
2. Claims 1, 5, 8-11, 13, 17-20, and 24-26 have been amended.
3. Claims 1, 2, 4-11, 13-21 and 23-26 are pending.

### ***Response to Arguments***

1. Applicant's arguments filed 30 November 2007 have been fully considered but they are not persuasive.
2. Referring to the rejection of claim 1, the Applicant contends that the prior art, Fischer provides for a digital signatures embodied in nested certificates, the certificates being used to indicate the authority of various individuals in a digital transaction. The Applicant contends that Fischer discloses what is actually embedded in the certificates as text associating with a key with particular individuals having authority to use the certificates, not the key itself nor provide a determination, but rather read a digital signature from an electronic certificate. The Applicant further contends that Fischer's operation is very different from a key being presented by or read from the second software module and determining whether the key is traceable to one of the keys in the set of keys embedded in the first software module.

The Examiner respectfully disagrees and asserts that according to the MPEP, Section 2114 – Manner of Operating the Device Does Differentiate Apparatus Claim from the Prior Art, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

In the instant case, the steps that the device takes to assign a trusted status to a key does not differentiate the prior art apparatus. In Fischer, there's a processor (See Column 9, lines 30-35 and Figure) and a machine readable medium coupled to the processor (See Column 9, lines 35-37) causing the processor to execute instructions for a method. Therefore, the device of Fischer anticipates the device of the Applicant.

Furthermore, Fischer discloses in Column 13, lines 46-65, a certifier may empower another person to cancel other certificates which the certifier has produced. The certifier is able to cancel or revoke a certificate in which if he or she has reason to believe it has been compromised therefore the certificate is revoked. This will prevent anyone from adding their digital signature to an existing certificate.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2, 4-11, 17-21, and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner did not find support within the Applicant's specification nor within the drawings describing the

claimed limitation wherein determining whether a key presented by or read from a **second software module** is traceable to one of the keys in the set of keys.

5. Therefore, the rejection of claims 1-2, 4-11, 13-21, and 23-26 are maintained in view the reasons above and in view of the reasons below.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 4-11, 13-21, and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (US Patent No. 5,214,702).

Referring to claims 1 and 20, Fishcer discloses a method comprising:

a public key cryptographic method and system for authenticating the identity of public key holder. The enhanced digital signature certification will allow trust to be assigned to a key. (See Abstract)

As shown in Column 12, lines 5-16 and 28-36, Fischer discloses reading from a software module of a meta-certifier, wherein the set of keys is embedded within the certificates that are associated with a trusted source (i.e. meta-certificate). (See Column 12, lines 5-16 and 28-36)

The certificates are accompanied by digital signatures wherein determining whether the key is traceable to one of a set of keys associated with the trusted authority is determined in Column 22, lines 20-26.

Fischer discloses a list of compromised keys which determines if the key can be identified by a valid digital signature in Column 19, lines 36-45.

Furthermore, if the key is not identified as a compromised key and is traceable to one of the keys in the set of keys (i.e. valid), the assigned key within the certificate will gain trusted status based upon a trust level as shown in Column 19, lines 10-23)

Referring to claims 2,14, and 21, Fischer discloses the claimed limitation wherein verifying the integrity of a document comprising the key and the list of comprised keys (See Column 21, lines 31-47)

Referring to claims 4,16, and 23, Fischer discloses the claimed limitation wherein determining whether the key is traceable to one of the keys in the set of keys (See Column 22, lines 20-26) further comprising:

tracing the key through a certificate chain to one of the keys in the set of keys (See Column 16, lines 22-27)

Referring to claim 5, Fischer discloses the claimed limitation wherein associating a document comprising the key and the set of keys with a software module comprising the set of keys using a hash of the software module in the document (See Column 24, lines 18-44)

Referring to claim 6, Fischer discloses the claimed limitation wherein the document is a manifest signed by the key (See Column 24, lines 18-44)

Referring to claim 7, Fischer discloses the claimed limitation wherein searching the list of compromised keys for the key (See Column 19, lines 36-48)

Referring to claims 8,17, and 24, Fischer discloses the claimed limitation wherein producing a document comprising an identification of a software module and a list of comprised keys in and digitally signing the document using a key traceable to one key of a set of keys, wherein the set of keys is embedded in the software module (See Column 19, lines 36-62)

Referring to claims 9,18, and 25, Fischer discloses the claimed limitation wherein the identification of the software module comprises a hash value of the software module (See Column 17, lines 45-62, Column 18, lines 6-13)

Referring to claims 10,19, and 26, Fischer discloses the claimed limitation wherein the key is traceable to one of the keys in the set of keys embedded the software module by way of a certificate chain (See Column 16, lines 22-27)

Referring to claim 11, Fischer discloses the claimed limitation wherein making the document available on a communication network by which computer systems comprising the software module may read the document (See Column 25, lines 23-35)

Referring to claim 13, Fischer discloses a device comprising  
a processor (See Column 9, lines 30-41)  
machine-readable storage for storing instructions, determining whether a key is traceable to one key of a set of keys associated with a trusted source (See Column 22, lines 20-26)

determine whether the key is identified in a list of comprised keys (See Column 19, lines 36-45)

and if the key is not identified as comprised and is traceable to one of the keys in the set of keys, assign the key a trusted status (See Column 19, lines 10-23)

Referring to claim 15, Fischer discloses the claimed limitation wherein a software module comprising the list of keys (See Column 19, lines 36-45)

### ***Conclusion***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to COURTNEY D. FIELDS whose telephone number is (571)272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.



Art Unit: 2137

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

/C. D. F./  
Examiner, Art Unit 2137  
February 15, 2008

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2137